

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABRAHAM CHERIAN

Appeal No. 1997-4195
Application No. 08/095,788

ON BRIEF

Before KIMLIN, WARREN, and LIEBERMAN, Administrative Patent Judges.

LIEBERMAN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 4 through 10, 13 and 14 which are all the claims remaining in the application.

THE INVENTION

The invention is directed to a simulated photo print making kit comprising four elements: a transparent substrate for a wrong reading image, which has a glass transition temperature substantially above that of toner particles; a smooth surfaced rigid member; an abhesive member; and a backing member with a light reflecting backing over the wrong reading image.

THE CLAIMS

Claims 14 is illustrative of appellants' invention and is reproduced below.

14. A simulated, photographic print making kit having components capable of being attached together using a heat and pressure member for forming a simulated photographic print, said kit comprising:

a transparent substrate member for having a wrong reading image xerographically formed thereon, said member having a glass transition temperature substantially above that of toner particles used to form said image;

a smooth surfaced rigid member for supporting said transparent substrate member in a flat position during creation of a simulated photographic print;

an abhesive member for use as a barrier between a backing member and a heat and pressure member during attachment of said transparent substrate and said backing member;
and

a backing member for attachment to said transparent substrate member to provide a light reflecting backing over said wrong reading image said backing member containing a coating of adhesive material for adhering said backing member to said transparent substrate member.¹

THE REFERENCES OF RECORD

As evidence of the prior art of record, the examiner relies upon the following references.

Malhotra	4,997,697	Mar 05, 1991
Whalen	5,197,763	Mar 30, 1993

THE REJECTION

Claims 4 through 10, 13 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Whalen in view of Malhotra.

OPINION

We have carefully considered all of the arguments advanced by appellant and the examiner and agree with the appellant that the aforementioned rejection under 35 U.S.C. § 103 is not well founded. Accordingly, we will not sustain this rejection.

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability, ” whether on the grounds of anticipation or

¹ Claim 1 as it appears in the Appendix to the Brief fails to contain the amendment thereto submitted in the amendment filed May 31, 1996, (Paper No. 16). We observe that claim 4 contains substantially identical language to that entered in the amendment of May 31, 1996, and thus claims 1 and 4 duplicates. See Manual of Patent Examining Procedure §706.03 (k) (7th ed., Rev. 1, Feb. 2000; 700-34-700-35).

obviousness. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the case before us, the examiner relies upon a combination of two references to reject the claimed subject matter and establish a *prima facie* case of obviousness. The basic premise of the rejection is that it would have been obvious to one of ordinary skill in the art to have substituted the indicia bearing sheet of Whalen for the transparent sheet of Malhotra. See Answer, page 7. We disagree.

We find that Whalen discloses an emergency medical data card, wherein a letter size blank paper form is completed and reduced twice by xerography to slightly smaller than credit card size. See Abstract and column 1, lines 38-57. Subsequently, the sheet is attached to a rigid plastic card. *Id.* The card may thereafter be surrounded by a laminate plastic. See Figures 2 and 4, and column 2, lines 8-22. In addition, the reduced paper may be mounted on the rigid plastic by use of an adhesive. See column 3, lines 1-2.

Notwithstanding our findings, there is no disclosure in Whalen for the utilization of a transparent sheet in place of paper. Neither is a backing member disclosed which provides a light reflecting backing, particularly over a wrong reading image (a mirror image). Nor has the examiner addressed the limitation of the claimed subject matter directed to the transparent substrate member having a glass transition temperature, T_g , substantially above that of toner particles.

In order to remedy these deficiencies, Malhotra is combined with Whalen. Although Malhotra is directed to a transparent substrate for receiving or containing a xerographic image, Abstract and

column 1, lines 5-41, there is no suggestion for the addition of backings, or rigid members as required by the claimed subject matter. Neither is there any rationale presented why a transparent substrate would be substituted for a paper substrate. Moreover, even if the substitution was made, we still would not obtain the invention of the claimed subject matter, as a light reflecting backing over a wrong reading image would be missing.

Based upon the above considerations, even if the examiner was correct in combining the Whalen and Malhotra in the manner supra, the structure created would, in any event, fall short of the invention defined by the claimed subject matter, as the aforesaid claimed subject matter requires features that cannot be achieved by combining Whalen and Malhotra. See Uniroyal Inc. v Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert denied, 488 U.S. 825 (1988).

Moreover, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would have selected the elements from the cited prior art references for combination in the manner claimed. We determine on the record before us that there is no reason, suggestion, or motivation to combine the references in the manner proposed by the examiner. Accordingly, the examiner has not established a prima facie case of obviousness. See In re Rouffet, 149 F.d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). The rejection of the examiner is not sustained.

DECISION

The rejection of claims 4 through 10, 13 and 14 under 35 U.S.C. § 103 as being unpatentable over Whalen in view of Malhotra is reversed.

The decision of the examiner is reversed.

REVERSED

EDWARD C. KIMLIN)
Administrative Patent Judge)

[illegible]

lp

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Appeal No. 1997-4195
Application No. 08/095,788

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DECISION: REVERSED

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s):

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PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT